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7 RECOR MEDICAL, INC.,  
8 Plaintiff,  
9 v.  
10 MEDTRONIC IRELAND  
11 MANUFACTURING UNLIMITED CO., et  
al.,  
12 Defendants.

Case No. 22-cv-03072-TLT (TSH)

**DISCOVERY ORDER**

Re: Dkt. No. 120

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14 Fact discovery is still ongoing, *see* ECF No. 96, and in ECF No. 120, Recor “moves  
15 pursuant to Rule 37 of the Federal Rules of Civil Procedure to compel Medtronic to identify ten  
16 out of the fifteen witnesses listed in its Initial Disclosures that Medtronic may rely on for summary  
17 judgment or may call as witnesses at trial.” *Id.* at 3. Recor says it wants to limit the depositions it  
18 takes to the people Medtronic will use on summary judgment or at trial and does not want to waste  
19 time and money deposing witnesses Medtronic is never going to use. Efficiency is an admirable  
20 instinct, but the Court doesn’t think it can force Medtronic to make that decision now. Nor does  
21 Recor identify anything in Rule 37, or in any other rule, that would authorize such an order at this  
22 stage of the case.

23 The Court understands the problem that an overdesignation in the initial disclosures may  
24 tend to obscure the witnesses you want to depose. But litigants rarely base their deposition  
25 decisions solely on the other side’s initial disclosures. Normally they rely more on the documents  
26 that get produced to identify which witnesses they want to depose.

27 Initial disclosures also rarely make clear who will be submitting declarations on summary  
28 judgment or who will be testifying at trial. That’s because initial disclosures are supposed to

1 disclose “each individual likely to have discoverable information . . . that the disclosing party *may*  
2 use to support its claims or defenses . . .” Fed. R. Civ. Proc. 26(a)(1)(A)(i) (emphasis added).  
3 This list may be overinclusive because it is not a list of who the disclosing party *will* use.

4 It sure would be convenient during fact discovery to have a binding list of ten people that  
5 your opponent can use later in the case, because then you would know exactly who to depose. On  
6 the other hand, that’s a mighty big commitment to make before discovery is even over and long  
7 before you know what your opponent is going to say on summary judgment. What if the other  
8 side’s summary judgment motion raises an argument you didn’t anticipate, you have the perfect  
9 witness to address it, but she’s not on your list of ten? After all, it’s not like you know for sure  
10 everything your opponent will say one day on summary judgment.

11 In short, there are good reasons why federal courts do not require this kind of commitment  
12 at this stage of the case. That may, and normally does, change later when pretrial disclosures are  
13 required, *see* Fed. R. Civ. Proc. 16(c)(2)(G) (“At any pretrial conference, the court may consider  
14 and take appropriate action on the following matters . . . identifying witnesses and documents,  
15 scheduling the filing and exchange of any pretrial briefs, and setting dates for further conference  
16 and for trial), but we’re still in fact discovery. There’s no basis to require this commitment of  
17 Medtronic now. Recor’s request is **DENIED**.

18 **IT IS SO ORDERED.**

19 Dated: March 21, 2025

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21 THOMAS S. HIXSON  
22 United States Magistrate Judge  
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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In these claims there is no proper antecedent basis in the ultimate parent claim for citation of "the additional contacting".

***Allowable Subject Matter***

Claims 1 and 21 are allowed.

Claims 7-9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: the prior art fails to show an electrical connection system for a piezoelectric element on a base member in which the electrical connection system comprises conducting elements (foil or otherwise) which are integral with a single conductor track which in turn is connected to an electrical connection element at a contacting zone of the electrical conductor track, at which location the base member is also connected.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Additional prior art has been cited which has at least some bearing on the claimed invention.

*hnd*  
tmd

March 15, 2005

*Thomas M. Dougherty*  
TOM DOUGHERTY  
PRIMARY EXAMINER